

### **REMARKS**

Claims 56-70 and 72-88 are pending in this application. Claim 72 is currently amended to remedy an informality. No new matter has been added. Applicant respectfully requests reconsideration and allowance in light of the following remarks.

#### **Present Examination**

For the reasons outlined below, Applicant respectfully requests the Examiner to remove the finality of this Office Action and to address the issues previously presented, which were not addressed by Examiner. Applicant respectfully notes that in the present Office Action Examiner has overlooked multiple arguments set forth by Applicant in the July 7, 2008 response and has taken actions which cause Applicant to question whether the previous response was properly considered. M.P.E.P. 707.07(f) states “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” In the previous response, Applicant submitted arguments indicating why the cited art (in this case the Zak reference) does not teach an exam form which has “pre-identified selectable data elements pertaining to said chief medical complaint.” *See* Response at 9-10. This argument was not addressed in the Response to Arguments section of the present Office Action. *See* Office Action at 11-12.

Additionally, Applicant showed that the cited art fails to teach “wherein certain of said presentations comprise a portion having a pre-identified graphic of an anatomical area pertinent to said chief medical complaint” (emphasis added). *See* Response at 11. It was noted that in Zak, the “body GUI” that is displayed is selected by a user “by simply touching the display of a particular body part...[so] the EMT user can easily associate focal patient complaints and exam findings with a particular body region, and ‘zoom in’ to document finer levels of detail. . . .” Zak at ¶ [0076]. In other words, in Zak the user must identify and/or narrow down the area of the body GUI that is displayed. The above-recited limitation requires that the graphic presented be “pre-identified” and “pertinent to said chief medical complaint,” neither of which are taught by Zak. This argument was also not addressed in the Response to Arguments section of the present Office Action. *See* Office Action at 11-12.

Further, in the Response to Argument section of the present Office Action, Examiner states that Applicant argued that Walker is non-analogous art. This statement is inaccurate in

that Applicant did not assert that Walker is non-analogous art. Applicant did argue, however, that one of skill in the art would not combine the cited references because the result would not function as asserted by Examiner and would not provide for the claimed invention. *See* Response at 8-9. In other words, it is Applicant's position that (i) the proposed combination would have no reasonable expectation of success, and (ii) that the result of the combination would be unsatisfactory for its intended purpose. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); MPEP 2143.02 ("The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success."); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP 2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."). This argument was also not addressed in the Response to Arguments section of the present Office Action. *See* Office Action at 11-12.

Applicant notes that there were additional arguments submitted that were not addressed (*e.g.* pre-generated reports from diagnostic-specific templates do not teach a "system programmed to generate a textual prose representation correlating information corresponding to selections of pre-identified data elements" (emphasis added)). These arguments, as well as additional arguments in response to the new grounds of rejection, are outlined below.

Applicant respectfully submits that the actions taken in the present case, and the uncertainty caused thereby, unfairly hinder Applicant when making determinations regarding how to proceed in prosecuting the present application. M.P.E.P. 706.07 states "[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant." Because there are not clear issues developed, Applicant requests that a new Office Action, with a corresponding new timeline for reply, be issued which action further explains the rejections, and the reasoning by which Examiner disagrees with Applicant's arguments.

### **Claim Rejections under 35 U.S.C. § 103**

Claims 56-70 and 72-88 are rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations. The Federal Circuit has stated that when determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention –

*including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Because the proposed combinations fail to teach one or more limitations of the claims, Applicant respectfully submits that the present rejections are improper.

**A. Zak in view of Walker**

Claims 56-77 and 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2002/0004729 as to Zak et al. (hereinafter “Zak”) in view of U.S. Publication No. 2002/0170565 as to Walker et al. (hereinafter “Walker”).

Claim 56 recites “certain of said presentations having at least an HPI portion, and an ROS portion for a particular medical complaint.” Applicant agrees with Examiner that Zak fails to teach an ROS portion for a particular medical complaint. Examiner relies on Walker ¶ [0102], fig. 9a, as teaching this limitation. However, this portion of Walker discusses the creation of an ROS portion for a diagnosis database template (*see* ¶¶ [0097-0099]). In Walker, multiple templates are generated and stored on a database, each template being for a specific medical diagnosis. Walker populates these templates with patient examination data (which could include ROS data) and history data. This data, however, has already been obtained without use of the templates of Walker. *See* ¶ [0095]. Applicant notes that the screen presentations of claim 56 are part of a “system for capturing medical information.” This is as opposed to the cited teachings of Walker which are geared to creating templates for processing information that has already been captured. This difference alone is enough to distinguish the present claim over the art. However, as is shown below, these differences create various functional anomalies that further make clear that (i) Walker does not teach the above-recited limitation; and (ii) the prior art references cannot be successfully combined.

The functionality of Walker as outlined above shows that Walker does not teach the above recited limitation. The asserted ROS portion of Walker is not “for a particular medical complaint” as required by the claim; rather it is for a probable diagnosis. *See* ¶ [0100]. The asserted templates of Walker cannot be construed as being “for a particular medical complaint” because all of the patient data that would be taken in response to a medical

complaint is already obtained when the physician is about to make a diagnosis using the templates of Walker. Applicant notes that a “diagnosis” is the end product of a physician’s work after analyzing a medical complaint and conducting an examination. As such, the “medical complaint” comes much earlier in the treatment process. Thus, in the art of medicine, complaints and diagnoses are significantly different, both substantively and temporally. Accordingly, the proposed combination fails to teach the above recited limitation of claim 1.

Further, one with skill in the art would not look to combine these references because the proposed combination would not function in the manner asserted by Examiner. The addition of the templates of Walker to the system of Zak would not merely add an ROS form to the system used by the emergency medical technician of Zak, such an addition would necessarily function to add an entire diagnosis portion to the system. Such an addition would not be practical. As a result, one of skill in the art would not look to combine these references because the combines systems would not function properly. It is further noted that the system resulting from the proposed combination (*i.e.* a diagnosis portion added to the system of Zak), clearly does not yield the claimed invention because of the substantive and temporal differences of diagnoses and medical complaints. Accordingly, Applicant respectfully submits that claim 56 is allowable over the cited art.

Claim 70 recites “capturing physical exam information pertaining to said patient on a second screen presentation of said selected template, said second screen presentation being one of said plurality of template presentations having pre-identified selectable data elements pertaining to said chief medical complaint.” Examiner cites fig 3 ‘exam’, of Zak as teaching this limitation. However it is noted Zak does not teach an *exam* presentation “having pre-identified selectable data elements pertaining to said chief medical complaint” as required by amended claim 70. Applicant notes that tailoring an examination presentation around a chief medical complaint creates considerable time savings for a physician (which is extremely valuable in an emergency setting), and none of the cited references teach such an aspect. Therefore, Applicant respectfully submits that claim 70 is allowable over the cited art.

Claim 86 recites “a plurality of said presentations having pre-identified selectable data elements pertaining to said chief medical complaint, and said system programmed to generate

a textual prose representation correlating information corresponding to selections of said pre-identified data elements.” Applicant agrees with Examiner’s assessment that Zak does not contain sufficient teachings to reject this claim. Examiner relies on figs. 19a-b of Walker as teaching “textual reporting.” *See* Office Action pg. 8. However, merely teaching textual reporting is insufficient to obviate the above-recited limitation. Paragraph 140 of Walker makes clear that the reports of Walker are pre-generated from diagnostic-specific templates. Walker does not teach generating a report by “correlating information corresponding to selections of pre-identified data elements.” In other words, a report that is pre-generated cannot be said to be generated in response to correlating selections of data elements pertaining to a chief medical complaint.

Further, assuming for the sake of argument that Examiner could read the diagnostic specific, pre-populated templates as selections of pre-identified data elements, Applicant notes that these data elements clearly are not “pertaining to [a] chief medical complaint” because they are explicitly in reference to a potential diagnosis. Those of skill in the art would readily recognize that a chief medical complaint and a diagnosis come at entirely different points of time during of patient care. Accordingly, such an interpretation would be improper. Thus, Applicant respectfully submits that claim 86 is allowable over the cited art.

Claims 57-69, 71-77, and 87-88 depend either directly or indirectly from independent claims 56, 70, and 86, and thus, inherit each and every limitation of their corresponding independent claims. As a result, claims 57-69, 71-77, and 87-88 are allowable for at least the reasons set forth above. Further, dependent claims 57-69, 71-77, and 87-88 contain aspects that are patentable in their own right.

For example, claim 60 recites “wherein certain of said presentations comprise a portion having a pre-identified graphic of an anatomical area pertinent to said chief medical complaint.” Examiner relies on figures 3-4 of Zak as teaching this limitation. However, as explicitly taught by Zak, the “body GUI” that is displayed is selected by a user “by simply touching the display of a particular body part...[so] the EMT user can easily associate focal patient complaints and exam findings with a particular body region, and ‘zoom in’ to document finer levels of detail. . . .” Zak at ¶ [0076]. In other words, the user must identify and/or narrow down the area of the body GUI that is displayed. These extraneous steps in

Zak slow functionality, which in an emergency setting, is undesirable. The above-recited claim requires that the graphic be “pre-identified” and “pertinent to said chief medical complaint.” This is clearly not taught by Zak as a user of Zak must select and zoom to obtain the desired graphic. Accordingly, for at least these reasons, claim 60 is allowable.

Claim 63 recites “wherein said exam presentations contain listings of pre-presented clinical items representing possible clinical exam findings pertinent to said particular medical complaint.” Examiner points to ¶¶ [0040], [0054-0055], and [0079] of Zak as teaching this limitation. However, there is no teaching in Zak that the exam form contains any pre-presented clinical items “pertinent to said particular medical complaint.” While Zak does discuss a problem form series that has a history portion for selected problem, there is no teaching that a selected problem on the problem form functions to tailor the exam form (or any form other than the history of problem form in the problem form series shown in fig. 5) with items “pertinent to said particular medical complaint.” Accordingly, for at least these reasons, claim 63 is allowable.

#### **B. Zak in view of Huang**

Claims 78 and 80-83 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zak in view of U.S. Patent 6,384,815 as to Huang (hereinafter “Huang”).

Claim 78 recites “wherein positive selections of the pre-identified selectable data elements are configured to be indicated by encircling one or more textual labels of said data elements.” Applicant notes that both Zak and Walker teach using radio buttons that are set off to the side of data elements (*see, e.g.*, Figures 3-7 of Zak, and Figure 4 of Walker). This is similar to the deficient layout described in [0002] in the background section of the present application which becomes exceedingly difficult for a user to navigate when dealing with large numbers of entries. Accordingly, neither Zak or Walker can be construed as teaching the above limitation. Examiner appears to agree with Applicant that Zak and Walker are deficient with respect to teaching claim 78. Office Action at 9. Examiner relies on Huang as teaching “circling or crossed out sections.” *Id.* However, it is unclear how Examiner is applying the Huang reference (*i.e.* whether the circling in Huang is relied on as making a selection of a data element).

Huang teaches a text editing/annotation tool. *See* Huang Abstract. The system allows a user to mark a document while automatically determining what kind of writing tool should apply (*e.g.* pen, highlighter, etc.). *Id.* at col. 4 ll. 62-66. These teachings are irrelevant to the present application. The marking or annotating in Huang does not function to indicate positive selections of the pre-identified selectable data elements. As such, Examiner would have to rely on other art for teaching indicating such selections. Both Zak and Walker teach the use radio buttons for indicating selections, which as explained above, is insufficient to teach the above recited limitation. As such, any combination of Zak and Walker with Huang would necessarily produce a product which had radio buttons to indicate selections. To the extent that a user could mark other text on a screen, such marking would serve no function. Accordingly, Applicant submits that the proposed combination fails to teach “wherein positive selections of the pre-identified selectable data elements are configured to be indicated by encircling one or more textual labels of said data elements.”

Claims 80-83 depend from independent claim 78, and thus, inherit each and every limitation of their corresponding independent claim. As a result, claims 80-83 are allowable for at least the reasons set forth above.

**C. Zak in view of Huang and further in view of Walker**

Claims 79 and 84-85 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zak in view of Huang and further in view of Walker.

Claims 79 and 84-85 depend either directly or indirectly from independent claim 78, and thus, inherit each and every limitation of their corresponding independent claim. As a result, claims 79 and 84-85 are allowable for at least the reasons set forth above.

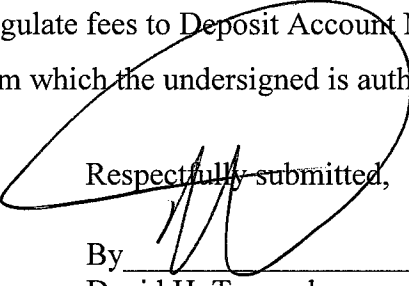
**CONCLUSION**

In view of the above, Applicant believes the pending application is in condition for allowance, and respectfully requests favorable reconsideration.

Applicant believes no fee is due with this response. However, if a fee is due, please charge any fees required or credit any overpayment during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees to Deposit Account No. 06-2380, under Order No. 68554/P001US/10801996 from which the undersigned is authorized to draw.

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Respectfully submitted,

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